

PUR-001/CON

Application No. 09/893,770

PATENT APPLICATION

#17

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Re the Patent Application of

Mary Purvis

Serial No. 09/893,770

Filed: June 29, 2001

For: REPLACEABLE COOLER TOPS
WITH SPORTS LOGO

)
) Group Art Unit: 3629

)
) Examiner: Michael J. Fisher

)
) Confirmation No. 5937

APPEAL BRIEF

Commissioner of Patents
P.O. Box 1450
Alexandria, Va 22313-1450

Sir:

This is an Appeal Brief under 37 C.F.R. §1.192 in response to the decision of the Examiner in the Final Office Action of July 1, 2003. Each of the topics required by Rule 192 is presented herewith and is labeled appropriately.

Real Party in Interest

This divisional application was filed on behalf of an individual inventor, Ms. Mary Purvis, Fayetteville, Arkansas. The application is currently unassigned; its entire right, title and interest remain in the inventor.

Related Appeals and Interferences

A Decision on an Appeal of the Applicant's parent application, No. 09/437,667, is relevant to the issues in this appeal, at the very least from the standpoint of stare decisis, if not collateral estoppel and/or res judicata. The claims in the parent application were apparatus claims; the claims in this application are corresponding method claims. No other appeals or interferences are known which will directly affect, be directly affected by or have any bearing on the Decision of the Board in this pending appeal. A copy of the Decision on Appeal in Appeal No. 2002-1406, dated January 31, 2003 is appended to this Brief for its relevance to the findings concerning the art cited.

Status of Claims

Claims 1 to 44 were filed in the parent application, and were replaced with method claims 45 to 62 in this divisional application at filing by a Preliminary Amendment.

In the initial Action of December 10, 2001, an election of species was required, notwithstanding that no election requirements were made in the parent.

In a Response to an Election of Species Requirement filed April 10, 2002, the species of Figs. 2A to 4 were elected, on which claims 45, 46, 51 through 54, and 62 read. Claims 45, 52 and 53 were urged as generic to the elected species.

In an initial Action on the merits of the elected claims, the elected claims were variously rejected, and a response filed.

Each of the claims 45, 46, and 51 to 54 and 62 stands as finally rejected. All pending claims are presented in the Appendix to this Brief on Appeal. It may be noted that the version of the claims presented in this appendix is exactly that of the claims as presented prior to the Final Action. No unentered amendments to the claims are pending

Status of Amendments

No amendments to the claims as they existed at Final Action were made or are pending for consideration.

Summary of the Invention

The Appellant's invention relates to the field of coolers and more particularly to insulated, portable, molded coolers with insulating walls, bottom and top of the type which include a removable top. The Appellant has proposed that the tops of such coolers be made such that several tops, having different indicia, be available for a common cooler bottom. By that technique, a person having a cooler with a particular top with indicia, such as a sports logo favoring one sport, could have a top suitable for that same cooler with another top with a different indicia.

Reference is made to pages 1 to 3 of the specification as filed. That narrative is of importance in considering the situation confronting the inventor, a fan of several different sports teams. The invention conceived, therefore, as noted in the first full paragraph of page 3 of the specification, seeks to provide a number of ways to provide several readily exchangeable tops for a common cooler bottom. Reference is made in the text to a "set" of at least two interchangeable portions, contemplating that more than one top, for example, is made for a common cooler bottom.

Features of the invention are summarized at pages 4 and 5 of the specification. The basic

feature can be gleaned from Figs. 1A to 1C where the invention contemplates two different, replaceable lids 22a and 22b for a common cooler bottom. Fig. 1D is directed to the same notion in which the alternative tops are interchanged at the hinges 25, 27. Figs. 2A and 2B of the application contemplate a cooler 40 with interchangeable tops 44 in which the tops are adhesively removable from the top 42 of the cooler 40.

The attachment secured to its top 42 and showing an adhesive line 43 is shown in Figs. 3 and 4. Fig. 5 shows an alternative so that a "VELCRO" brand fastener is used. Fig. 6 shows an alternative in which guide members 52 receive alternative cooler tops 48. Figs. 7A and 7B show an alternative attachment structure for the interchangeable tops for the common cooler bottom, as better explained in Figs. 8 and 9.

Reference is also made to the description of the preferred embodiments on pages 6 to 12 of the specification as filed. The invention is further summarized in the paragraph on page 12 of the text.

References of Record Relied Upon in the Final Action

The following are the references relied upon by the Examiner in the final rejection:

1. Allegedly conventional Coleman coolers, the availability of which as a reference to be relied upon is challenged, hereafter referred to as "conventional coolers".
2. U.S. Des. Pat. No. DES 378,562 to Miller et al.. ("Miller '562")
3. U.S. Des. Pat. No. DES 369,946 to Miller et al. ("Miller '946").

4. U.S. Pat. No. 5,801,766 to Blackwelder (“Blackwelder”).
5. U.S. Pat. No. 2,919,829 to Forrer (‘829).
6. U.S. Pat. No. 2,584,254 to Brodbeck “254).

Issues Presented for Consideration in this Appeal

The issues presented for consideration in this appeal are as follows:

1. Whether the findings regarding Miller D378,562; Miller D369,946; “conventional coolers”; and Blackwelder are consistent with the findings of the Board in the appeal in the parent application.
2. Whether claims 45 and 51 were properly rejected under 35 USC 102(b) as anticipated by Miller D378,562.
3. Whether claims 45 and 51 were properly rejected under 35 USC 103(a) as being unpatentable over Miller D369,946 and Miller D378,562 in view of “conventional coolers”.
4. Whether claims 52, 53 and 62 were properly rejected under 35 USC 103 (a) as being unpatentable over Miller as applied to claims 45 and 51 above, and further in view of Blackwelder.
5. Whether claims 46 and 64 were properly rejected under 35 USC 103(a) as being unpatentable over Miller in view of Blackwelder as applied to claims 45, 51 to 53, and 62 above, and further in view of either one of Forrer “829 and Brodbeck ‘254

Grouping of Claims

Each of claims 45 to 62 stands or falls separately with respect to the plethora of rejections advanced in the Final Action. For convenience, though, for the Examiner, Board and the Appellant's attorney, they will be argued as grouped above, but not necessarily in the order stated. It will be appreciated that all of the claims will ultimately be addressed with respect to all of the rejections by the close of this Brief on Appeal.

Arguments are made in this Brief on Appeal (semble) with respect to the separate status of each of the claims.

Confusion as to which Miller reference as applied to claims 45 and 51 is referred to in the rejections of claims 52, 53, and 62 on the one hand and claims 46 and 64 (sic) on the other.

Reference is made in the rejections on page 4 of the Final Action to a "Miller" reference as applied to claims 45 and 51. This notation conceivably applied to two separate Miller design patents; both therefore will be argued. In addition, it is believed that the reference to claim 64 is a typo and that claim 62 is intended. These arguments will proceed with those assumptions, notwithstanding the argument that improper notice of the grounds of rejection was give.

Argument**First Preliminary Matter**

The examiner, in rejecting claims 45 and 51 referred to "Coleman cooler lids being brightly colored" and "coleman coolers have an affixing perimeter on the lid". The rejection is founded on anticipation, so that reference to Coleman coolers is either improper, or the basis of

the rejection should be under section 103.

In the Final Office Action in the parent dated September 15, 2000, the Examiner for the first time rejected claims based on a “conventional Coleman six-pack coolers that have existed since the 1980’s”. It was the position of the Examiner that he had “had in his possession since that time a molded plastic six-pack cooler comprising a white container and a blue top.” He further alleged that: “These types of coolers came in variation of a white container and tops in at least blue, green and red tops. Accordingly, Coleman had in its possession a set of interchangeable different colored portions (cooler tops) in conjunction with standard white containers to form plural different color motif insulated storage devices. A plurality of the various colored tops would be produced with the common white containers, and the Coleman producers would have this set. The applicant’s representatives may make an appointment to view the examiner’s sample should the description be questioned.”

This assertion is traversed under §2144.03 and an affidavit or declaration of the Examiner was requested to support the factual basis of the assertion and the inferences derived from the factual assertions. This traversal is timely in that it is the first response to the Final Action. Moreover, a reference to that effect would be preferred. Such an affidavit was provided, critiqued in the Brief on Appeal in the parent, and subjected to a counter-affidavit by the undersigned. Applicant thus preserves all challenges to this hindsight position of the examiner.

Moreover, the inference derived by the Examiner from the alleged factual basis is founded on speculation derived from the application of the Appellant. Thus, it is founded in hindsight. It is noted that the assertion of the inference has no basis in fact, other than what “would be produced”. Moreover, whether two tops were available to the public for a single cooler bottom is not addressed. Since the undersigned is not aware that a cooler from Coleman

having two tops and one cooler bottom were made, used or sold by the public, rather than in a confidential private environment during manufacture, a challenge to this information is made as not constituting public prior art.

Withdrawal of this basis for the rejections is respectfully requested. For purposes of this appeal, it will be assumed *arguendo* that a coolers with different colored tops are available to the public, a fact apparent from the art cited by the Appellant based on the admissions in the specification and the prior art submitted in the IDS.

We turn therefore to the rejections advanced by the Examiner.

Preliminary Remarks Relative to the Board Decision.

Propriety and Responsiveness of the Final Action to the Board Decision

A copy of the Decision of the Board of Appeals and Patent Interferences in the parent application is appended to this Brief. It is relevant to the proposed findings of the examiner as to Miller '946 (see pages 11 and 12); Blackwelder (pages 14 and 15); and "Coleman coolers", only to the extent allegedly established by the Gehman declaration (pages 5 to 10).

It is the fundamental position of the Applicant that the findings of the Board as to the Miller '946 design patent, when applied to utility claims whether method or apparatus, also apply to the Miller '562 patent. When those findings that Miller '946 is ambiguous are coupled with the findings that "conventional coolers" evidence is restricted, and that Blackwelder would not have suggested its applicability to Miller '946, all of the rejections cannot be sustained. Therefore, given the specific limitations, the rejection of each claim can be considered separately and cannot be sustained.

Res Judicata and Collateral Estoppel

The MPEP at 706.03(w) and 707.07(g) recognizes the doctrine of res judicata, and by implication its corollary doctrine of collateral estoppel. The decision of the Board, and the facts and law thus found by the Board and concluded in that decision are binding on the Examiner, at the very least as part of the law of the case. When so applied, the use of the Gehman declaration is limited according to the findings of fact and conclusions of law stated in the prior decision, for example at pages 6 to 8, and 9 to 12.

The prior findings as to Miller

The Decision of the Board, at pages 11 to 12 finds Miller '946 to be an ambiguous reference in that it is not possible to determine, based on the drawing figures of the Miller reference, whether the lid of Miller is affixed to a substantially planar portion of the cooler. According, the application of Miller in the combination with the Gehman affidavit is so limited by the findings of fact and conclusions of law as to Miller. In addition, the use of Miller is proscribed as noted in the paragraph spanning pages 14 and 15 of the Decision of the Board. The Board had concluded, in a reverse context, but with findings applicable here, that there is nothing within the teaching of the applied references (including Miller) which would have suggested the desirability and thus the obviousness of a modification of Miller.

But even assuming the extremely limited value of Gehman, Blackwelder relates to a hat with interchangeable display panels. Thus, Blackwelder is non-analogous art for at least the same reason that Blackwelder in the prior decision was non-analogous art. Accordingly, even if it is assumed that Blackwelder is available (as the Board assumed, but did not find as fact or law), nothing in its teachings suggests the desirability and thus the obviousness of the

modification of the German findings (as limited by the Board's decision) and Miller, as discussed above.

The motivations purported to be found in the last full paragraph of page 5 of the Action and the paragraph spanning pages 5 and 6 are not found in the art, but rather in the "wish list" of findings stated by the examiner. Those findings sound in hindsight analysis, based only on the Applicant's specification and not anywhere in the art. It is fundamental to this responsive position that nothing in the references suggests the modifications or motivates the modifications stated in the Action. Reference may be made to the record for case citation and arguments on this point incorporated by reference as is fully stated herein.

The Examiner erred in rejecting claims 45 and 51 as allegedly being anticipated by the design patent to Miller '562.

The Examiner erred in rejecting claims 45 and 51 as obvious over Miller '946 and Miller '562 in view of "conventional coolers"

The Examiner erred in rejecting claims 52, 53 and 62 as being unpatentable over Miller (either Miller reference) and further in view of Blackwelder.

The Examiner erred in rejecting claims 46 and 64 as being unpatentable over Miller (either Miller reference) in view of Blackwelder and further in view of either one of Forrer and Brodbeck.

The guiding law and introductory factual response are stated above with respect to the Board decision. As to Miller '946, its design disclosure does not anticipate the expressed limitations of claims 45 and 51 for the reasons well stated in the prior Board decision. The Board pointed out that Miller '946 is a design patent for the ornamental design of coolers. Miller

'562 is also a design patent. Because as the Board pointed out, anticipation cannot be predicated on an ambiguous reference, the anticipation rejection and any rejection relying on the Miller design patents must fall. Specifically, it is not possible to tell whether at least the "releasably affixing" step of claims 45 and 51 is met by either Miller reference or whether the lid of either Miller reference is affixed to a planar or substantially planar portion of the cooler, as recited. As in the prior case, the unsupported statement of the examiner is thus not persuasive.

Because either Miller design patent is ambiguous, for at least the reasons found by the Board as to the Miller '946 patent, all rejections as to these method claims cannot be sustained. Thus rejections of claims 45 and 51, and claims 52, 53 and 62 cannot be sustained because Miller is applied. Each of the claims, argued separately if needed, has limitations not found in the applied Miller reference (whichever Miller design patent is intended) alone or in combination with Blackwelder.

Still further, to the extent that Blackwelder is applied to claims 53, 53 and 62 on one hand, or to claims 46 and 64 (sic: 62) on the other, we adopt the views of the Board that, even if it is assumed that Blackwelder is analogous art, there is nothing within the teachings of the applied references (i.e. Miller '946 and Blackwelder) which would have suggested the desirability and thus the obviousness of the modifications proposed.

Given this view of the appeal, it is not necessary to specifically argue Forrer or Brodbeck, except to note that there is no reasoning whatsoever supplied as to the motivation for combining Forrer's or Brodbeck's findings, even if otherwise accurate, to the pending claims.

Conclusion

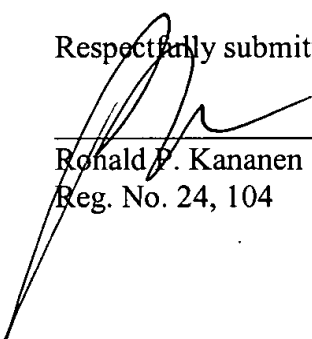
The rejections of each of the pending claims cannot be sustained.

DATE: May 3, 2004

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Claims

45. (amended) A method of releasably attaching predetermined indicia to an insulating cooler device having an insulating cooler and at least a pair of interchangeable structural members for said cooler, comprising the steps of:

providing a structural member sized and dimensioned in a manner that is structurally compatible with a body of an insulating cooler and having the predetermined indicia thereon;

applying a releasable affixation device to said structural member; and

releasably affixing said structural member to a planar portion of said insulating cooler using said releasable affixation device, whereupon said affixing step includes a step of non-destructively exchanging one structural member having a first predetermined indicia for another structural member having a second predetermined indicia on said body.

46. A method of attaching predetermined indicia to an insulating cooler device according to claim 45, wherein said applying step comprises the step of applying adhesive to the said structural member.

47. (amended) A method of attaching predetermined indicia to an insulating cooler device according to claim 45, wherein said applying step comprises the step of applying a hook and loop type of fastener.

48. A method of attaching predetermined indicia to an insulating cooler device according to claim 45, wherein said applying step comprises the step of applying a plurality of guide

members.

49. A method of attaching predetermined indicia to an insulating cooler device according to claim 45, wherein said applying step comprises the step of applying an elastomeric band, so dimensioned as to extend around a periphery of said structural member.

50. A method of attaching predetermined indicia to an insulating cooler device according to claim 45, wherein said applying step comprises the step of applying magnets or ferromagnetic metal structurally arranged so as to mate with magnets or ferromagnetic metal attached to said insulating cooler device.

51. A method of attaching predetermined indicia to an insulating cooler device according to claim 45, wherein said predetermined indicia is a sports logo.

52. A method of interchanging attachments for an insulating cooler device, said attachments having predetermined indicia thereon, said method comprising the steps of:

- a) providing an insulating cooler device having a substantially planar portion;
- b) providing a plurality of interchangeable structural members, each said interchangeable structural member having the predetermined indicia thereon;
- c) releasably affixing one of said plurality of interchangeable attachments to said substantially planar portion using said releasable affixation device for a first predetermined time period;

d) removing said one interchangeable attachment from said substantially planar portion;
and

e) releasably affixing another of said plurality of interchangeable attachments to said substantially planar portion for a second predetermined time period.

53. A method of interchanging attachments for an insulating cooler device according to claim 52, further comprising the step of:

applying a releasable affixation device to each of said plurality of interchangeable attachments.

54. A method of interchanging attachments for an insulating cooler device according to claim 52, wherein said applying step comprises the step of applying adhesive to the said structural member.

55. A method of interchanging attachments for an insulating cooler device according to claim 53, wherein said applying step comprises the step of applying a VELCRO brand fastener.

56. A method of interchanging attachments for an insulating cooler device according to claim 53, wherein said applying step comprises the step of applying a plurality of guide members.

57. A method of interchanging attachments for an insulating cooler device according to claim 53, wherein said applying step comprises the step of applying an elastomeric band so

dimensioned as to extend around a periphery of said interchangeable attachment members.

58. A method of interchanging attachments for an insulating cooler device according to claim 53, wherein said applying step comprises the step of applying magnets or ferromagnetic metal structurally arranged so as to mate with magnets or ferromagnetic metal attached to said insulating cooler device.

59. A method of interchanging attachments for an insulating cooler device according to claim 53, wherein said interchangeable attachment is a removable cover, and wherein said applying step comprises the step of integrally attaching a structural member to said removable cover that mates with a body portion of said insulating cooler device.

60. A method of interchanging attachments for an insulating cooler device according to claim 59, wherein said integrally attaching step comprises attaching a plurality of mortises or tenons, so dimensioned as to mate with corresponding tenons or mortises, respectively, on said insulating cooler device.

61. A method of interchanging attachments for an insulating cooler device according to claim 59, wherein said integrally attaching step comprises attaching an elastomeric band around a periphery of said removable cover.

62. A method of interchanging attachments for an insulating cooler device according to claim 52, wherein said predetermined indicia is a sports logo.



The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

PPH/BKD 80183-8007

March 31, 2003

Paper No. 26

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

in reconsideration / Appeal to C.A.F.C.
3-31-03

Ex parte Mary Purvis

Appeal No. 2002-1406
Application No. 09/437,667

ON BRIEF

MAILED

JAN 31 2003

PAT. & T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Before COHEN, STAAB, and McQUADE, Administrative Patent Judges.

STAAB, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal from the examiner's final rejection of claims 1-26. An amendment after final rejection canceling claims 27-44 has been entered. No other claims are currently pending.

The Invention

It is an objective of appellants' invention to provide a single cooler or container with a set of two or more readily exchangeable tops or sides, each representing, for example, a different sports team of interest. In a first embodiment of the invention (e.g., Figures 1A-1C), a plurality of interchangeable tops 22 bearing different team logos is provided for a single cooler body. Claim 1 is an exemplary claim directed to the first embodiment. In another embodiment of the invention (e.g., Figures 2A, 2B) a plurality of interchangeable attachments 44 bearing different team logos is provided for removable securement to a top or side of the cooler. In this embodiment, the securing means can be a temporary adhesive, hook and loop fasteners, magnets, etc. Claim 6 is an exemplary claim directed to this embodiment.

The Prior Art

The examiner relies upon the following as evidence of anticipation/obviousness of the claimed invention:

The declaration of Examiner Bryon P. Gehman, executed July 19, 2001, pertaining to facts within the personal knowledge of the examiner.¹

Hicks et al. (Hicks)	D. 325,493	Apr. 21, 1992
Miller et al. (Miller)	D. 369,946	May 21, 1996
Blackwelder	5,803,266	Sep. 8, 1998

¹A copy of the Gehman declaration is attached to this decision.

The Rejections

The following rejections are before us for review:

- (a) claims 6-14, rejected under 35 U.S.C. § 112, second paragraph, as being indefinite;
- (b) claims 1-3, 6, 8, 15, 16, 19, 20 and 23, rejected under 35 U.S.C. § 102(b) as being anticipated by the Gehman declaration;
- (c) claims 15, 16, 19, 20, and 23, rejected under 35 U.S.C. § 102(b) as being anticipated by Hicks;
- (d) claims 15, 16, 19, 20, 23 and 26, rejected under 35 U.S.C. § 102(b) as being anticipated by Miller;
- (e) claims 1-6, 8 and 10, rejected under 35 U.S.C. § 103 as being unpatentable over Hicks; and
- (f) claims 1-26, rejected under 35 U.S.C. § 103 as being unpatentable over Hicks or Miller in view of Blackwelder.

Reference is made to appellant's main and reply briefs (Paper Nos. 12 and 18) and to the examiner's answer (Paper No. 16) for the respective positions of appellant and the examiner regarding the merits of these rejections. The declaration of attorney Ronald P. Kananen executed October 23, 2001 has been submitted in support of appellant's position.²

²A copy of the Kananen declaration is attached to this decision.

Discussion

Rejection (a)

Claims 6-14 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite.

The criterion for compliance with the second paragraph of 35 U.S.C. § 112 is “whether a claim reasonably apprises those of skill in the art of its scope.” *In re Warmerdam*, 33 F.3d 1354, 1361, 31 USPQ2d 1754, 1759 (Fed. Cir. 1994).

The examiner’s first rationale in support of this rejection is that the term “said interchangeable attachment” in lines 2-3 of claim 6 lacks a proper antecedent and/or is inconsistent with the term “more than one interchangeable attachment” recited earlier in the claim. However, we believe one skilled in the art would understand the term “said interchangeable attachment” in lines 2-3 as referring to each of the previously recited “more than one interchangeable attachment.”

Next, the examiner considers that the terms “said planar portion” and “said insulating device” appearing at several places in claims 6-14 is improper and indefinite because these terms refer to elements (or portions of elements) that are not positively recited as part of the claimed invention. According to the examiner, only positively recited structure may be referred to by use of the term “said”. We know of no *per se* rule of claim drafting, and the examiner has referred us to no such rule, supporting the examiner’s position in this regard. From our perspective, one skilled in the art would have no difficulty determining which elements recited in the claims are positively recited as part of the claimed subject matter and which are not.

Finally, the examiner considers that dependent claim 8 is unclear in that it states that the "set" of claim 6 "is one of a top and a side" of the insulating device. The examiner's point is well taken. Claim 6 is directed to a "set" comprising "more than one interchangeable attachment" and "means for removably securing said attachment to a planar portion of an insulating device." In contrast, claim 8, which depends from claim 6, states that the "set" of claim 6 "is one of the a top and a bottom side of said insulating device." The language of dependent claim 8 is inconsistent with that of claim 6 and raises questions as to the scope of the dependent claim. This is so because in base claim 6 the insulating device is only inferentially recited, whereas claim 8 states or at least implies that the "set" of claim 6 includes as a positively recited element thereof one of a top and a bottom of the insulating device inferentially recited in the base claim. For this reason, the standing 35 U.S.C. § 112, second paragraph, rejection of claim 8, as well as claim 10 that depends therefrom, will be sustained.

Rejection (b)

Claims 1-3, 6, 8, 15, 16, 19, 20 and 23 stand rejected under 35 U.S.C. § 102(b) as being anticipated by the Gehman declaration.

In proceeding before it, the PTO applies to the verbiage of claims the broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art, taking into account whatever enlightenment by way of definitions or otherwise that may be afforded by the written description contained in the applicant's specification. *In re Morris*, 127

F.3d 1048, 1054, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997). In the present case, appellant's specification does not specifically define the terms "set" and "indicia" appearing in the claims. Consistent with appellant's specification, we find the broadest reasonable interpretation of the term "set" to be "a group of articles of uniform design"³, and the broadest reasonable interpretation of the term "indicia" to be "an identifying marking used to single out one thing from another."⁴

Considering first independent claim 1, we find the scope of claim 1 to be a "set of interchangeable portions" comprising "more than one said interchangeable portion" with each said portion "having indicia thereon" and being "structurally adapted" to mate with a non-interchangeable portion of an insulating device. We find that neither the "insulated storage device" as a whole, nor the "non-interchangeable portion" thereof, is part of the claimed "set". In addition, we note that claim 1 does not require the interchangeable portions to be different in any way from one another.

The Gehman declaration relied upon by the examiner in support of this rejection states, among other things, that (1) Examiner Gehman personally owned "since the mid 1980s" a

³See Webster's Third International Dictionary of the English Language Unabridged, G. & C. Merriam Company, copyright © 1971, wherein the noun "set" may mean "39 a: a group of articles of uniform design."

⁴See Webster's Third International Dictionary of the English Language Unabridged, G. & C. Merriam Company, copyright © 1971, wherein "indicia" may mean "b : an identifying marking or verbal statement used to single out one thing from another . . . or to serve as directional guides."

"Coleman six-pack cooler" comprising "a white molded plastic base portion and a blue molded plastic separable lid," (2) at the time of purchase "coolers of the same size that comprised a white molded plastic base portion and a green molded plastic separable lid, and coolers that comprised a white molded plastic base portion and a red molded plastic separable lid, were also on sale," and (3) "[t]he white molded plastic base portions were all of the same construction, while the lids only differed in the color of plastic chosen to provide the lid." The examiner asserts that (4) "[a]ccordingly, the merchant selling these coolers and the Coleman organization, at some time, each retained a set of interchangeable portions for an insulated storage device, any one white molded plastic base portion being usable with any one of the blue, green or red lids."

Anticipation by a prior art reference does not require either the inventive concept of the claimed subject matter or recognition of inherent properties that may be possessed by the reference. *See Verdegaal Bros., Inc. v. Union Oil Co.*, 814 F.2d 628, 633, 2 USPQ2d 1051, 1054 (Fed. Cir.), *cert. denied*, 484 U.S. 827 (1987). The law of anticipation does not require that the reference teach what an appellant is claiming, but only that the claims on appeal "read on" something disclosed in the reference. *Kalman v. Kimberly-Clark Corp.*, 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), *cert. denied*, 465 U.S. 1026 (1984).

We understand assertion (4) of the Gehman declaration to mean that at various points in the manufacture and marketing of Coleman six-pack coolers there existed a collection or assemblage of said coolers, each said cooler consisting of a cooler base portion and a colored separable lid. It is

our view that claims 1-3 "read on" such a collection or assemblage of said Coleman six-pack coolers. More particularly, the separable lids of the collection or assemblage would comprise a "set" of interchangeable portions in that the lids constitute a group of articles of like design. While we appreciate that each lid of the collection or assemblage of coolers would be associated with a particular base portion such that there would be a one-to-one correspondence between cooler base portions and cooler lids, this circumstance does not preclude the collection or assemblage of coolers from anticipating claims 1-3. The claim term "set" does not define a collection of interchangeable portions that distinguishes over the lids of the prior art collection or assemblage of coolers because, among other things, the non-interchangeable portion of the insulated storage device is not positively recited as a part of the claimed subject matter. Further, because claim 1 is in open ended "comprising" format, it does not preclude the existence of cooler base portions in addition to the base portion the interchangeable lids are adapted to mate with. Concerning the requirement that the interchangeable portions have indicia thereon, the color of the lids of the Coleman six-pack coolers comprises "indicia" in that it may serve as an identifying marking to single out a particular lid from a lid of a different color.

In light of the foregoing, we will sustain the examiner's rejection of claims 1-3 as being anticipated by the Gehman declaration.

Appellant's arguments in the main and reply briefs, as well as the declaration of attorney Ronald P. Kananen in support thereof, have been considered. For the most part, our position with

respect to appellant's arguments and evidence (i.e., the Kananen declaration) should be clear from our reasoning as set forth above. We add the following for emphasis.

Regarding the examiner's position that Coleman had in its possession a set of interchangeable different colored cooler tops for use in conjunction with standard white containers, appellant maintains on page 3 of the reply brief that "[i]t is equally probable that Coleman only provided a top/bottom cooler set, without consideration of an additional interchangeable top for a given bottom." As should be apparent from our discussion above, our position with respect to the anticipation rejection of claims 1-3 based on the Gehman declaration does not depend on a plurality of additional interchangeable tops for a given bottom being provided at any particular point in time. As indicated above, the term "set" is a broad term that does not distinguish over the lids of the prior art collection or assemblage of coolers. Moreover, claims 1-3 are broad in scope in the sense that they do not preclude the presence of cooler base portions in addition to the base portion the interchangeable lids are adapted to mate with. Accordingly, the lids of a collection or assemblage of Coleman six-pack coolers anticipate the "set" of interchangeable portions claimed in claims 1-3.

Turning to claims 6, 8, 15, 16, 19, 20 and 23, independent claim 6 is directed to a "set" comprising more than one interchangeable attachment and means for removably securing the interchangeable attachment to a *planar portion* of an insulating device. Independent claim 15 is directed to an "attachment device" comprising a structural member and an affixation device,

wherein the structural member and the affixation device are dimensioned to releasably affix the structural member to a *substantially planar portion* of an insulating storage device.

The Gehman declaration does not set forth any particulars of the interface connection between the lid and base of the Coleman six-pack cooler beyond the statement that "any one white molded plastic base portion [is] usable with any one of the blue, green or red lids." Nevertheless, in explaining the rejection of claims 6 and 15, the examiner states (answer, page 6) that "the top of the Coleman structure has mating structure to fix the top of a *planar* portion to the container" (emphasis added).

The initial burden of establishing a basis for denying patentability to a claimed invention based on prior art rests upon the examiner. See *In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984). In order to satisfy this burden, the examiner has the duty of supplying a *factual basis* to support the rejection he advances. See, for example, *In re Warner*, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967). In the present case, the factual basis for the examiner's rejection is the Gehman declaration. Unsupported statements made by the examiner in the answer that serve to expand or add to the Gehman declaration, and in particular the statement on page 6 of the examiner's answer to the effect that the top of the Coleman six-pack cooler has mating structure to fix the top to a *planar* portion of the container, are not part of the factual basis.⁵ Based on the

⁵Maintaining a line of distinction between statements made by an examiner in a declaration and statements made by that same examiner in an Office action is not a matter of
(continued...)

record before us, there is nothing in the factual basis for the rejection that supports the examiner's position as set forth in the answer that the cooler of the Gehman declaration has mating structure to fix the top to a *planar* portion of the container. We are therefore constrained to reverse the anticipation rejection of claims 6 and 15, as well as claims 8, 16, 19, 20 and 23 that depend therefrom, based on the Gehman declaration.

Rejections (c) and (d)

Claims 15, 16, 19, 20 and 23 stand rejected as being anticipated by Hicks and claims 15, 16, 19, 20 23 and 26 stand rejected as being anticipated by Miller.

As noted above, independent claim 15 is directed to an "attachment device" comprising a "structural member" and an "affixation device," wherein the structural member and the affixation device are dimensioned to *releasably* affix the structural member to a *substantially planar* portion of an insulating storage device. Claims 16, 19, 20, 23 and 26 each depend from claim 15.

Hicks and Miller are design patents for the ornamental design of coolers. Accordingly, the drawing figures constitute essentially the entire disclosure. In rejecting claim 15 as being anticipated by the coolers of Hicks and Miller, the examiner finds correspondence between the

⁹(...continued)

form over substance. Statements made in a declaration are made with knowledge that willful false statements are punishable by fine or imprisonment. It is for this reasons that such statements are treated as evidence. The same cannot be said of unsupported statements made by an examiner in an Office action.

claimed "structural member" and the lids of the coolers of the references and finds correspondence between the claimed "affixation device" and the joint or engagement between the lids and the cooler bodies of the references. According to the examiner "the structural member and affixation device [of each reference are] dimensioned as to *releasably* affix to an insulating cooler device at a *planar* portion (at least the sides of the container and conventionally the topmost portion of the container in either Hicks et al or Miller et al)" (answer, page 7; emphasis added).

Anticipation cannot be predicated on an ambiguous reference. See *In re Turlay*, 304 F.2d 893, 899, 134 USPQ 355, 360 (CCPA 1962). In the present case, it is not possible to determine, based on the drawing figures of the references alone, whether the lid of Hicks is *releasably* affixed to the cooler, or whether the lid of Miller is affixed to a *substantially planar* portion of the cooler, the examiner's unsupported statement to the contrary notwithstanding. For these reasons, the anticipation rejection of claims 15, 16, 19, 20 and 23 based on Hicks, and the anticipation rejection of claims 15, 16, 19, 20 23 and 26 based on Miller, cannot be sustained.

Rejection (e)

Claims 1-6, 8 and 10 stand rejected under 35 U.S.C. § 103 as being unpatentable over

Hicks.

Claim 1 is directed to a "set of interchangeable portions" comprising "more than one said interchangeable portion" with each said portion "having indicia thereon" and being "structurally adapted" to mate with a non-interchangeable portion of an insulating device. Claims 2-5 depend

either directly or indirectly from claim 1. Claim 6 is directed to a "set" comprising "more than one interchangeable attachment" and "means for removably securing" the interchangeable attachment to a planar portion of an insulating device. Claims 8 and 10 depend either directly or indirectly from claim 6.

The design patent to Hicks discloses two embodiments of the ornamental design for a cooler, the Figures 1-7 embodiment and the Figures 8-14 embodiment. In rejecting these claims as being anticipated by Hicks, the examiner states that Hicks discloses "a set (the lids of Figure 1 and Figure 8) of interchangeable portions of an insulating device, each interchangeable portion having a different indicia thereon" (answer, page 8). As to claim 6, the examiner further states that "Hicks et al further disclose an insulating device" (answer, page 8). In the "Response to Arguments" section of the answer, the examiner further explains that "the two different designs [of Hicks] [are] obviously interchangeable" and that "the rejection is made based on the obviousness of interchanging elements of the two embodiments" (answer, pages 12-13).

While we appreciate that Hicks discloses two cooler design embodiments, each embodiment is a separate and distinct cooler design. We do not view Hicks as teaching or suggesting that the design features or structural elements of one embodiment may be interchanged with those of the other. Accordingly, the § 103 rejection of claims 1-6, 8 and 10 based on Hicks cannot be sustained.

Rejection (f)

Claims 1-26 stand further rejected under 35 U.S.C. § 103 as being unpatentable over Hicks or Miller in view of Blackwelder.

Blackwelder relates to a clothing accessories kit having interchangeable ornaments. As set forth in the abstract, the accessories kit

allow[s] a user to coordinate a clothing accessory with a variety of outfits without the expense of purchasing a separate clothing accessory for each outfit. The accessories kit includes a clothing accessory and a plurality of decorative, interchangeable ornaments for attachment to the clothing accessory. At least one of the ornaments is secured to the exterior surface of the clothing accessory by a VELCRO® fastener. The accessories kit further includes a storage container for conveniently organizing the clothing accessory and the plurality of ornaments therein.

In rejecting the appealed claims as being unpatentable over Hicks or Miller in view of Blackwelder, the examiner appears to take the position that it would have been obvious to one of ordinary skill in the art in view of Blackwelder to modify the coolers of Hicks and/or Miller such that the indicia on the lids of the coolers is removable and interchangeable with other indicia.

Appellant argues, first, that Blackwelder constitutes nonanalogous art. In the view we take in this case, even if we assume that Blackwelder is analogous art, the obviousness rejection based on Hick or Miller in view of Blackwelder is not well founded.

Having carefully considered the examiner's position in maintaining this rejection, we conclude that there is nothing within the teachings of the applied references which would have suggested the desirability, and thus the obviousness, of the modification of Hicks and Miller

proposed by the examiner. While it is true that an objective of Blackwelder is to improve the appearance of accessories for clothing by providing interchangeable ornaments for attachment thereto, we see no reasonable basis for modifying the cooler designs of Hicks and/or Miller by making surface ornamentations thereof removable and interchangeable, as apparently proposed by the examiner, in light of Blackwelder. Simply put, the thrust of Hicks and Miller of providing a pleasing ornamental design for a cooler for storing food and beverages, and that of Blackwelder of providing a clothing accessory that may be readily customized to coordinate with a number of different "outfits" in order to reduce the expense of providing specific accessories for each "outfit", are so fundamentally different from one another that we do not consider that a person of ordinary skill in the art would have found it obvious to modify one in view of the other without improper reliance on appellant's disclosure and teachings. This being the case, the examiner's rejection of claims 1-26 based on Hicks or Miller in view of Blackwelder will not be sustained.

Remand

This case is remanded to the examiner for consideration of the following matters.

Our reversal of the standing § 102 rejection of claims 6, 8, 15, 16, 19, 20 and 23 based on the Gehman declaration was predicated on the fact that the Gehman declaration did not contain sufficient details concerning the construction of the Coleman six-pack cooler in the examiner's possession. As set forth in M.P.E.P. §2144.03, when the examiner relies on facts within the examiner's personal knowledge in order to reject a claim, the data should be stated *as specifically as*

possible, and the facts must be supported by an affidavit or declaration when called for by appellant. The examiner has not done this. Accordingly, the examiner should consider the patentability of, for example, claims 6 and 15 in view of the specific construction of the Coleman six-pack cooler stated to be in the examiner's possession. In the event the examiner is of the view that said cooler anticipates or renders obvious any of appellant's claims, the examiner should (1) execute a new declaration specifically setting forth the structural details of the Coleman cooler, and (2) enter a new rejection based on the facts presented in the newly executed affidavit or declaration. The specifics of the cooler's construction may be set forth in the affidavit or declaration in any form deemed appropriate by the examiner (e.g., photographs, sketches, etc.).

As should be apparent from our analysis of the claims, appellant's claims are broad in scope. The examiner should consider the patentability of appellant's claims in light of conventional arrangements of known articles of manufacture that one would encounter on a daily basis. For example, claim 1 would appear to be anticipated by a stack of conventional plastic lids for use with disposable foamed coffee cups that one would encounter at a self service beverage station of a convenience store. In this regard, the stack of lids comprises "a set of interchangeable portions" for an insulated storage device (the disposable foamed cup) and typically are imprinted or embossed with indicia (e.g., "CAUTION HOT"). In this same vein, claims 6 and 15 would appear to be anticipated by a plurality of conventional refrigerator magnets affixed to the door of a refrigerator, it

being noted that such magnets typically include indicia in the form of a decorative appearance and/or written words.

Summary

The rejection of claims 6-14 under 35 U.S.C. § 112, second paragraph, is affirmed as to claims 8 and 10, but is reversed as to claims 6, 7, 9 and 11-14.

The rejection of claims 1-3, 6, 8, 15, 16, 19, 20 and 23 as being anticipated by the Gehman declaration is affirmed as to claims 1-3, but is reversed as to claims 6, 8, 15, 16, 19, 20 and 23.

The rejection of claims 15, 16, 19, 20, and 23 as being anticipated by Hicks is reversed.

The rejection of claims 15, 16, 19, 20, 23 and 26 as being anticipated by Miller is reversed.

The rejection of claims 1-6, 8 and 10 as being unpatentable over Hicks is reversed.

The rejection of claims 1-26 as being unpatentable over Hicks or Miller in view of Blackwelder is reversed.

In addition, this case is remanded to the examiner for consideration of the manners set forth above.

In addition to affirming the examiner's rejection of one or more claims, this decision contains a remand. 37 CFR § 1.196(e) provides that _____

whenever a decision of the Board of Patent Appeals and Interferences includes or allows a remand, that decision shall not be considered a final decision. When appropriate, upon conclusion of proceedings on remand before the examiner, the Board of Patent Appeals and Interferences may enter an order otherwise making its decision final.

Regarding any affirmed rejection, 37 CFR § 1.196(b) provides:

Appellant may file a single request for rehearing within two months from the date of the original decision. . . .

The effective date of the affirmance in this case is deferred until conclusion of the proceedings before the examiner unless, as a mere incident to the limited proceedings, the affirmed rejection is overcome. If the proceedings before the examiner do not result in allowance of the application, abandonment or a second appeal, this case should be returned to the Board of Patent Appeals and Interferences for final action on the affirmed rejection, including any timely request for rehearing thereof.

This application, by virtue of its "special" status, requires immediate action, see MPEP § 708.01.

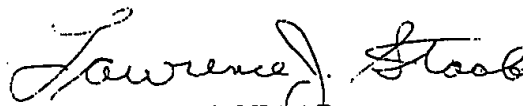
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No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

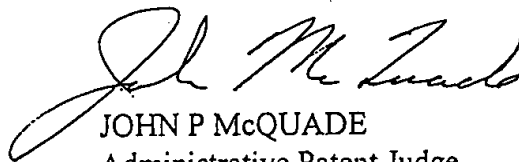
AFFIRMED-IN-PART; REMANDED



IRWIN CHARLES COHEN
Administrative Patent Judge



LAWRENCE J. STAAB
Administrative Patent Judge



JOHN P. McQUADE
Administrative Patent Judge

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Appeal No. 2002-1406
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